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| EXAMINER |
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HARVEY, DIONNE

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| ART UNIT | PAPER NUMBER |
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2643

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,869

Applicant(s)

HAWKINS ET AL.

Examiner

Dionne N Harvey

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/14/01
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, **the headset and headset plug of claim 29**, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 16 and 17 recite the limitation "the second operation" in line 2. There is insufficient antecedent basis for this limitation in the claim.
2. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Lines 5-6, recite "the application". Does this refer to the phone application or the computing application?
3. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Line 3 recites "device either includes a headset or a headset is plugged into the device". The Specification fails to disclose a wireless headset for the device. Therefore, how is the device enabled to interact with the phone application via pivoting switch when the device **includes** a headset?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 11,12 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haraguchi (US 6,813,416)** in view of **Raisanen (US 6,502,090)**.

Regarding claims 1 and 20, In **column 1**, Haragichi teaches a portable information terminal such as a pager, PDA or cellular phone which reads on "A mobile device comprising"; the device providing a plurality of applications such as "**SELECT AUDIBLE ALERT**", "**MEMO**", "**ALARM CLOCK**" "**SCROLL MODE**" which reads on "mobile computing application" and device also including a transceiver unit **21R, 21T**, which reads on "phone application"; Haragichi further teaches that the device includes a jog dial switch **17**, which reads on "a user-controllable pivoting input switch"; the switch **17** being operational by an upward rotation, a downward rotation and pressing, which reads on "wherein a plurality of operational modes direct the operation of the mobile computing application". Haragichi does not clearly teach that switch **17** performs an operation in the phone application.

However, in **column 3, lines 60-65**, Raisanen teaches that it is well known in the art to construct an electronic apparatus such that the provided buttons/switches have varying functions dependent upon the mode in which the device is operating. It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Haragichi and Raisanen, such that switch **17** performs a desired function both in the computing application and in the phone application, thereby reducing the number of switches necessary to operate the device and thus simplifying it's operation.

Regarding claim 2, Haragichi teaches that the switch **17** pivots about an axis for at least one of the operational modes.

Regarding claim 3, Haragichi teaches that the switch is a rotary switch.

Regarding claim 4, Raisanen teaches that rocking switches **2** are well known in the art.

Regarding claim 5, Haragichi teaches in **column 5, lines 31-36** that switch **17** adjusts the downward movement of the screen, thereby reading on "wherein one operational mode requires the rotation of the pivoting switch in the clockwise direction about the axis."

Regarding claim 6, Haragichi teaches that switch **17** adjusts the upward movement of the screen, thereby reading on, "wherein another operational mode requires the rotation of the pivoting switch in the counterclockwise direction about the axis."

Regarding claim 7, in **column 10, lines 15-17**, Haragichi teaches that switch **17** may be pressed to enter a desired operation, thereby reading on "wherein another operational mode requires pressing in the switch."

Regarding claims 11 and 12, the combination of Haragichi and Raisanen does not clearly teach that the rotation of the switch directs the phone application to adjust the volume of a phone conversation during an active call session. However, it would have been obvious for one of ordinary skill in the art at the time of the invention to substitute one switch's function for the other, since doing so would not in any way affect the functionality or proper operation of the device.

Regarding claim 21, the apparatus of Haragichi inherently teaches a method of operating a mobile device that has a pivoting input switch **17**, a computing application, and a phone application (**see detailed rejection of claim 1 and 20**); Haragichi teaches that by rotating switch 17 upward, the screen is adjusted in a first direction, and by rotating the switch downward, the screen is adjusted in a second direction, thereby reading on "rotating the switch in the first direction to direct the computing application to perform a second operation." Haragichi does not clearly teach that switch **17** performs an operation in the phone application.

However, in **column 3, lines 60-65**, Raisanen teaches that it is well known in the art to construct an electronic apparatus such that the provided buttons/switches have varying functions dependent upon the mode in which the device is operating. It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Haragichi and Raisanen, such that switch **17** performs a desired function both in the computing application and in the phone application, thereby reducing the number of switches necessary to operate the device and thus simplifying its operation.

Regarding claim 22, in **column 10, lines 15-17**, Haragichi teaches that switch **17** may be pressed to enter a desired operation, thereby reading on "pressing in the switch to direct the operation of at least one of the applications."

5. Claims 8-10, 13-19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Haraguchi (US 6,813,416)** in view of **Raisanen (US 6,502,090)** and further in view of **Silverbrook (US 6,788,293)**.

Regarding claims 8 and 23, the combination of Haraguchi and Raisanen teach that it is well known in the art to construct switches that are actuatable in a plurality of orientations. The combination of Haraguchi and Raisanen does not clearly teach that the switch is constructed such that another operational mode requires pressing in the switch and holding the switch in this state for a duration of time.

In **column 11, lines 47-50**, Silverbrook teaches that a pressable switch may be constructed such that by holding, rather than pressing momentarily, an additional function may be realized. It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Haraguchi, Raisanen and Silverbrook, further reducing the number of switches necessary to perform various functions in the device.

Regarding claims 9 and 10, the combination of Haraguchi, Raisanen and Silverbrook does not clearly teach that the pressing and holding of the switch directs the phone application to perform a redial operation OR that the pressing and holding of the switch directs the phone application to terminate an active call session. However, as evidenced by the claims, it would have been obvious for one of ordinary skill in the art at the time of the invention to construct the device such that the switch is operable to perform any variety of the device functions, since doing so would not in any way affect the functionality or proper operation of the device.

Regarding claim 13, as discussed in the rejection **claims 1 and 20** above, the combination of Haragichi and Raisanen teaches a portable terminal operable as a PDA, cellular phone etc., which reads on "a mobile device comprising: at least one application"; the portable terminal including a rotatable switch **17**, as described in Haragichi, and a rocker switch **2**, as described in Raisanen, either switch readable on "a user-controllable pivoting input switch"; Haragichi teaches a plurality of modes of operation, reading on "that can be operated in at least first and second modes, wherein each operational mode directs the operation of the application, wherein the first mode requires the switch to pivot about an axis,"; In **column 11, lines 47-50**, Silverbrook teaches that a pressable switch may be constructed such that by holding, rather than pressing momentarily, an additional function may be realized, thereby reading on, "and the second mode requires pressing in the switch and holding the switch in this state for a duration of time."

Regarding claim 14, Haragichi teaches that the switch can be rotated in both a clockwise direction about the axis and a counter-clockwise direction, thereby reading on, " wherein the first operational mode requires the rotating of the switch in the clockwise direction about the axis, wherein the switch can be operated in a third mode by rotating the switch in the counterclockwise direction about the axis."

Regarding claim 15, in **column 10, lines 15-17**, Haragichi teaches that switch **17** may be pressed to enter a desired operation, reading on "wherein another operational mode requires pressing in the switch towards the axis."

Regarding claims 16 and 17, **as best understood with respect to the U.S.C. 112 second paragraph rejection above**, and as evidenced by the claims, it would have been obvious for one of ordinary skill in the art at the time of the invention to construct the device such that the switch is operable to perform any variety of the device functions, since doing so would not in any way affect the functionality or proper operation of the device.

Regarding claim 18, the combination of Haraguchi, Raisanen and Silverbrook does not clearly teach that the rotation of the switch directs the phone application to adjust the volume of a phone conversation. However, it would have been obvious for one of ordinary skill in the art at the time of the invention to substitute one switch's function for the other, since doing so would not in any way affect the functionality or proper operation of the device.

Regarding claims 19, the combination of Haraguchi, Raisanen and Silverbrook does not clearly teach that the pivoting of the switch directs the phone application to adjust the volume of a phone conversation during an active call session. However, it would have been obvious for one of ordinary skill in the art at the time of the invention to substitute one switches function for the other, or to substitute one type of switch for another, since doing so would not in any way affect the functionality or proper operation of the device.

6. Claims 24-28 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Richards (US 5,141,540)** in view of **Haraguchi (US 6,813,416)**.

Regarding claim 24, in **figure 3**, Richards teaches a mobile device comprising : a display screen **114**, a lid **102** removably covering the display screen, said lid having a transparent element **108** that allows at least a portion of the display screen to be visible while the lid covers the display screen; and at least one application (**the device operates in a telephone application and a dispatch application**); Richards further teaches that switches **202,204 and 206** direct operation of the application, even when the lid cover is closed. Richards does not clearly teach that the switch is a pivoting input switch.

Haraguchi teaches a portable information terminal usable as a cellular phone wherein the device is provided on the sides portion with a pivoting input switch **17**.

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Richards and Haraguchi, substituting the rotatable and pressable switch **17** of Haraguchi for pressable switches **202,204 and 206** of Richards, thereby reducing the number of switches necessary to perform Push-to-talk and volume adjustment functions.

Regarding claim 25, in **figure 3**, Richards teaches that the lid **102** pivotally couples to the device, wherein the lid can be in at least a retracted state and an extended state, wherein in the retracted state the lid covers the display screen **114**, and in the extended state the lid does not cover the display screen, wherein the lid rotate about is pivotal **112** connection to the device to go from one state to another.

Regarding claim 26, Richards teaches that the application is a phone application.

Regarding claim 27, the combination of Richards and Haraguchi teaches that the pivoting input switch **17 OR 202,204,206** allows a user to interact with the phone application while the lid covers the display screen.

Regarding claim 28, Richards teaches that the Push-to-talk function of switch **206** allows the user to initiate a telephone call while the lid covers the display screen. Richards teaches that the pivoting switch **206**, being pressable, may also be adapted to perform the push to talk feature.

Regarding claim 30, Haraguchi teaches that at least one of the applications displays a graphical user interface ("GUI") to a user (**see figures 10A-11J**), and the pivoting input switch **17** allows a user to interact with the GUI while the lid covers the display screen **see Figure 5**.

Regarding claim 31, both Richards and Haraguchi teach that the devices are operable to include a phone application.

Regarding claim 32, Haraguchi teaches a plurality of applications such as **"SELECT AUDIBLE ALERT", "MEMO", "ALARM CLOCK" "SCROLL MODE"** which reads on, "the application is a computing application."

Regarding claims 33 and 34, Richards and Haraguchi do not clearly teach that the device is provided with Internet browsing and email capabilities. However, the Examiner takes Official Notice that providing wireless devices with Internet browsing capabilities and access to email, is well known in the art and would have been obvious for the purpose of providing wireless subscribers with more extensive electronic access.

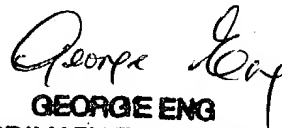
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne N Harvey whose telephone number is 703-305-1111. The examiner can normally be reached on 9-6:30 M-F and alternating Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dionne Harvey


GEORGE ENG
PRIMARY EXAMINER